



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097003,047	01/05/98	VAN DUYN	A 261922003302

KATE H MURASHIGE
MORRISON & FOERSTER
2000 PENNSYLVANIA AVENUE N W
WASHINGTON DC 20006-1888

HM21/0721

EXAMINER
ZAGHMOUNT, D

ART UNIT	PAPER NUMBER
1549	4

DATE MAILED: 07/21/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/003,047

Applicant(s)
Van Ooyen et al.

Examiner
Ousama Zaghmout

Group Art Unit
1649



☒ Responsive to communication(s) filed on Jan 5, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1 and 19-60 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1 and 19-60 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1649

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 19-20, 36, 39, 42, 45, 48, 51, 54-59,⁶⁰ are drawn to nucleic acid molecule encoding exo-1,3- β -glucanase, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in class 800, subclass 205 for example.
- II. Claims 1, 19, 21-25, 36, 39, 42, 45, 48, 51, 54-59,⁶⁰ are drawn to nucleic acid molecule encoding exo-1,3- α -glucanase, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in class 800, subclass 205 for example.
- III. Claims 1, 26-28, 36, 39, 42, 45, 48, 51, 54-59,⁶⁰ are drawn to nucleic acid molecule encoding endoglucanase, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in class 800, subclass 205 for example.

Art Unit: 1649

IV. Claims 29-32, 37, 40, 43, 46, 49, 52, 54-59^{b^o} are drawn to nucleic acid molecule encoding xylanase, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in class 800, subclass 205 for example.

V. Claims 33-35, 38, 41, 44, 47, 50, 53-59^{b^e} are drawn to nucleic acid molecule encoding starch de-branching enzyme (pullulanase), vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in class 800, subclass 205 for example.

The inventions are distinct, each from the other because each is drawn to molecularly and biochemically divergent products and processes not required by the other.

The inventions of group I, II, III, IV and V are drawn to completely different DNA molecules which encode completely different proteins and the use of one of any protein from any invention does not depend on the use of any other protein from inventions of other groups.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as evidenced by their divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Kate H. Murashige on May 13, 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though be traversed (37 CFR 1.143).

Serial Number: 09/003,047

Page 4

Art Unit: 1649

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently amendment of inventorship must be accompanied by a diligently-filled petition under 37 CFR 1.148(b) and the fee required under 37 CFR 1.17(h).

Art Unit: 1649

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Douglas Robinson, can be reached on (703) 308-2897. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.
July 2, 1998

A handwritten signature in black ink, appearing to read 'Douglas W. Robinson', with a stylized, cursive script.

**Douglas W. Robinson
Supervisory Patent Examiner
Technology Center 1600**